

K. DEE. *OP1634/18*
Docket No. 55293-A/JPW/AJM/MVM *#6*
11/4/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Carlos Cordon-Cardo et al.

Serial No.: 09/329,917

Examiner: J. Souaya

Filed : June 10, 1999

Group Art Unit: 1634

For : MARKERS FOR PROSTATE CANCER

Confirmation No.: 8767

Issue Fee Due: October 23, 2002

1185 Avenue of the Americas
New York, New York 10036
October 10, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231
Box ISSUE FEE

Sir:

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
AND CERTIFICATION PURSUANT TO 37 C.F.R. §1.97(e)(1)

In accordance with the duty of disclosure under 37 C.F.R. §1.56, applicants would like to direct the Examiner's attention to the following references which are listed on Form PTO-1449 (**Exhibit A**).

1. PCT International Application No. PCT/US98/14566, filed July 14, 1998, International Publication No. WO99/04238, published January 28, 1999 (**Exhibit 1**);
2. PCT International Application No. PCT/US98/01922, filed January 29, 1998, International Publication No. WO98/33450, published August 6, 1998 (**Exhibit 2**);
3. Cordon-Cardo, Carlos, et al. (1998) "Distinct Altered Patterns of p27^{KIP1} Gene Expression in Benign Prostatic Hyperplasia and Prostatic Carcinoma" J. Natl. Cancer Inst. 90(17): 1284-1291;

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4. Cote, R.J., et al. (1998) "Association of p27^{Kip1} Levels With Recurrence and Survival in Patients With Stage C Prostate Carcinoma" J. Natl. Cancer Inst. 90(12): 916-920;
5. DeMarzo, A.M., et al. (1998) "Prostate Stem Cell Compartments: Expression of the Cell Cycle Inhibitor p27kip1 in Normal, Hyperplastic, and Neoplastic Cells" Amer. J. Path. 153(3): 911-919 (**Exhibit 3**);
6. Fernandez, P.L. et al. (1999) "Expression of p27/kip1 Is Down-regulated in Human Prostate Carcinoma Progression" J. Path. 187(5): 563-566 (**Exhibit 4**);
7. Guo, Y., et al. (1997) "Loss of the Cyclin-dependent Kinase Inhibitor p27^{Kip1} Protein in Human Prostate Cancer Correlates with Tumor Grade¹" Clin. Cancer Res. 3: 2269-2274;
8. Lloyd et al. (1999) "P27^{Kip1}: a Multifunctional Cyclin-dependent Kinase Inhibitor with Prognostic Significance in Human Cancers" American J. Pathology 154(2): 313-323; and
9. McArthur, J.G. et al. (1999) "Cancer Gene Therapy with Novel Chimeric P27/p16 Tumor Suppressor Genes" Proceed. Amer. Assoc. Cancer Res. Ann. 40: 630 (**Exhibit 5**).

A Supplementary Partial European Search Report was issued on July 11, 2002 in connection with European Application No. EP 00938256.5, which is a related foreign counterpart of the subject application. A copy of the Supplementary Partial European Search Report is

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attached hereto as **Exhibit B**. Above-listed references 1-9 were cited in the **Supplementary Partial European Search Report**. References 3, 4 and 7 were submitted to and considered by the United States Patent and Trademark Office in an Information Disclosure Statement filed on May 23, 2000 in connection with the subject application. Reference 8 was submitted to and considered by the United States Patent and Trademark Office in a Supplemental Information Disclosure Statement filed on December 19, 2000 in connection with the subject application. Accordingly, copies of these references are not required to be provided to the United States Patent and Trademark Office, since they were previously submitted to and considered by the United States Patent and Trademark Office. References 1, 2, 5, 6 and 9 are attached hereto as **Exhibits 1-5**, respectively.

A Notice of Allowance and Issue Fee Due was issued on July 23, 2002 in connection with the subject application. The Notice states that the issue fee is due on October 23, 2002. The issue fee has not yet been paid. Pursuant to 37 C.F.R. §1.97(d)(1) and in compliance with 37 C.F.R. §1.97(e)(1), applicants hereby certify that each item of information contained in this Supplemental Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Supplemental Information Disclosure Statement. Accordingly, applicants respectfully request consideration of this Supplemental Information Disclosure Statement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number

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provided below.

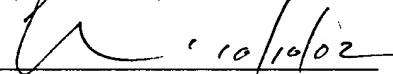
Pursuant to 37 C.F.R. §1.97(d)(2), no fee other than the enclosed \$180.00 fee is deemed necessary in connection with the filing of this Supplemental Information Disclosure Statement. If any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, Box ISSUE FEE.


Alan J. Morrison
Reg. No. 37,399

Date
10/10/02

Applicant Carlos Cordon-Cardo et al. *Sml.*
Client MSK (1747) File No. 55293-A Ally JPW/AJM/MVM
Date October 10, 2002

Kindly acknowledge receipt of the accompanying

Supplemental Information Disclosure Statement And Certification Pursuant To 37 C.F.R. §1.97(e) (1), in connection with Carlos Cordon-Cardo et al., for MARKERS FOR PROSTATE CANCER, U.S. Serial No. 09/329,917, filed June 10, 1999, including, Exhibit A (PTO Form 1449), Exhibit B (Supplementary Partial European Search Report), Exhibits 1-5 (References), a check in the amount of \$18,000 and a Certificate of Mailing dated October 10, 2002.

Date Due: October 11, 2002.

by placing your receiving date stamp hereon and returning it to us.

